

REMARKS

The Examiner asserts that restriction to one of Groups I and II is required under 35 U.S.C. §121. The Examiner notes that the claims of both groups are classified under the same class, namely class 705, but the claims of Group I are in subclass 80, and the claims of Group II are in subclass 76.

The Examiner argues that these claims are distinct because the inventions of Groups I and II are related as subcombinations disclosed as usable together in a single combination. The Examiner relies on M.P.E.P. § 806.05(d), which states in part:

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other.

M.P.E.P. § 806.05(d) indicates that the "examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." (emphasis added). Therefore, the examiner must first identify a disclosed "combination" to which both subcombinations are usable together, and second, must show that one of the subcombinations has "utility" other than in the disclosed combination.

The Applicant respectfully submits that the Examiner has not made such a showing. The Applicant first respectfully submits that the Examiner has confused claims being "separately usable" with claims having different claim recitations. As required by M.P.E.P. § 806.05(d), the examiner must show that one of the subcombinations has *utility* other than in the disclosed combination. It is first noted that the Examiner has not identified the single, disclosed combination to which the subcombinations are usable together. In any event, in an effort to show separate usability, the Examiner has simply identified a claim recitation in Claim 41 as a reason for separate usability. This claim recitation from Claim 41 is as follows: "validating the signature by the trusted system and sending the signed contract to the merchant system."

It is noted that claims of Group I, such as Claim 1, involve sending the contract to the merchant system. Therefore, the Examiner's required, stated basis for separate usability rests entirely on "validating the signature" in the Group II claims.

The Applicant contends that "separate usability" pursuant to M.P.E.P. § 806.05(d) requires that one of the claimed subcombinations, taken as a whole, has utility other than in the disclosed combination. The Examiner has not identified the "combination" to which such reference is made. In any event, assuming that such a combination exists, the examiner has not shown separate usability of the inventions of Group I and Group II, but instead has merely identified that Group II involves claims including "validating the signature." The Applicant argues that the Examiner has not properly established that validating the signature results in separate usability *of the invention* of either group vis-à-vis a single combination to which both subcombinations are usable. If merely identifying a single claim recitation such as "validating the signature" in one group of claims that is not recited in another group of claims results in separate utility supportive of a restriction requirement, virtually any claim not identical to another claim would be subject to a restriction requirement under such a rationale. The Applicant respectfully submits that this is not the purpose or meaning of M.P.E.P. § 806.05(d), and therefore submits that the requirement for restriction is improper for failure to make the requisite showing.

In the aforementioned arguments, Applicant is contesting the propriety of the Examiner's requirement for restriction. Because Applicant believes the Examiner has not made the showing required by M.P.E.P. § 806.05(d) by failing at least to identify the single disclosed combination to which the subcombinations are usable together, and to show the separate usability of the subcombination (versus a selected recitation from a claim) in such a combination. The Applicant does not reach the issue of whether such identified subcombinations are patentably distinct from one another, as it is respectfully submitted that the Examiner has not made the requisite showing under M.P.E.P. § 806.05(d).

CONCLUSION

In view of the above, the Applicant respectfully requests reconsideration and withdrawal of the requirement for restriction. If the Examiner believes it necessary or helpful, the undersigned attorney of record may be contacted at 651-686-6633, x110 to discuss any issues related to this case.

Respectfully submitted,

Crawford Maunu PLLC
1270 Northland Drive
Suite 390
St. Paul, MN 55120
651/686-6633

By: 

Steven R. Funk
Reg. No. 37,830

RECEIVED
CENTRAL FAX CENTER

OCT 14 2003

OFFICIAL